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Philips Steven Newton

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/598,988
Filing Date: September 18, 2006
Appellant(s): NEWTON ET AL.

Philips Steven Newton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/16/2009 appealing from the Office action mailed 10/15/2008.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-10 are pending. **Claims 1-10** are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUND(S) OF REJECTION

New grounds of rejection have been rendered with respect to **Claims 7 and 8** under 35 USC 112 2nd paragraph.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2004/0204073	Yanosy	10-2004
2002/0161934	Johnson et al.	10-2002
6,421,717	Kloba et al.	06-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. **Claims 1-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yanosy* (U.S. Pub. No. 2004/0204073 A1) in view of *Johnson et al* (U.S. Pub No. 2002/0161934 A1).

As to **Claims 1 and 6-8**, *Yanosy* discloses a method of providing data storage for a user device (**Mobile device 10; Figure 1**) comprising providing an application interface (**Virtual Operating System 104; Figure 2**) which enables access to a virtual local storage by an application running on the user device (**Application 103; Figure 2**) by processing a request from the application to store auxiliary data associated with the application in the virtual local storage, and, when a storage request is received, having the auxiliary data stored on the remote server via the network (**Application 103 makes a request to store auxiliary data (Step 1001, Figure 11; Paragraph 0030). VOS 104 receives a request from Application 103 for Shareable Resources 122 or “virtual storage” and enables said virtual resources on the mobile device for storage of said data (Step 1002-1004, Figure 11 and 16; Paragraphs 0031-0034 and 0045).**

However, *Yanosy* does not expressly disclose initiating a socket connection between a user device and a remote server.

Johnson, in the same field of endeavor, teaches **using socket connections between a user device, Host Systems, and a remote server, Server connected to Storage Devices. Paragraphs 0056-0057).**

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine creating socket connections between the user device and server as taught by *Johnson* with the data storage system of *Yanosy*. The motivation would have been to provide communications between the server and client on an IP based network.

As to **Claims 2 and 5**, *Yanosy-Johnson* further discloses wherein having the auxiliary data stored includes storing a user identification (**Paragraph 0030**).

As to **Claims 4 and 9**, *Yanosy* discloses a method of storing auxiliary data from at least one user on a remote server that is connectable to a user device via a network for providing storage for the user device comprising initiating a connection by a storage application in the user device in response to a request for access to a virtual local storage by an application running on the user device to store auxiliary data associated with the application in the virtual local storage, receiving, via the network, requests for storing auxiliary data from the application running in the user device, and when a storage request is received, storing the auxiliary data on the remote server (**Application 103 makes a request to store auxiliary data (Step 1001, Figure 11; Paragraph 0030). VOS 104 receives a request from Application 103 for Shareable Resources 122 or “virtual storage” and enables said virtual resources on the mobile device for storage of said data (Step 1002-1004, Figure 11 and 16; Paragraphs 0031-0034 and 0045).**

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However, *Yanosy* does not expressly disclose the connection between the storage application and a remote server being a socket connection.

Johnson, in the same field of endeavor, teaches **using socket connections between an application programming interface in a user device, and a remote server. Paragraphs 0044 and 0056-0057).**

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine creating socket connections between the user device and server as taught by *Johnson* with the data storage system of *Yanosy*. The motivation would have been to provide communications between the server and client on an IP based network.

As to **Claim 10**, *Yanosy-Johnson* further discloses computer program instructions that are executable by the processor to generate and transmit at least one stream of real-time information **(Figure 2; Paragraph 0024).**

NEW GROUND(S) OF REJECTION

Claims 7 and 8 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the following means (or step) plus function limitation: control means for performing applications that may generate auxiliary data relating to the applications, and processing means for executing a storage application for initiating a socket connection to a remote server via the network, and control means are arranged for retrieving applications to be performed from the storage medium.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC

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§ 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function: control means, such as the control unit 20, is shown in FIGs 1-2, for performing applications that may generate auxiliary data relating to the applications and processing means, such as a control unit 20, for executing a storage application for initiating a socket connection to a remote server via the network.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to be more than simply a general

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purpose computer or microprocessor. The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor.

The specification only connotes the recited control means and the processing means as general purpose computers or processors.

Specifically, the specification does not provide the algorithm for the claimed control means for performing applications and processing means for executing a storage application and as such appellants have failed to adequately describe sufficient structure for performing the functions claimed.

The specification does not provide the algorithm for the claimed control means for retrieving applications to be performed from the storage and as such appellants have failed to adequately describe sufficient structure for performing the functions claimed.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies individually.

As per appellant's argument that:

(1) "Storing data on a remote server in response to a request to store data from an application running on the user device is nowhere disclosed or suggested in Yanosy. Rather, Yanosy merely discloses to provide access to a remote service provider is in response to a service augmentation."

In reply to argument (1), examiner respectfully disagrees. Figure 16, Paragraph 0045, *Yanosy* teaches Mobile Device Application 103, at Step 1501, making a request to store data on a remote server, Shareable Network Resource 122, and storing data on said remote server at Step 1512.

For the above reason, Claims 1-10 stand rejected.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

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rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/R. B. M./

Examiner, Art Unit 2456

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Jack Harvey/

Director, Technology Center 2400

Conferees:

/Rupal D. Dharia/

Supervisory Patent Examiner, Art Unit 2400

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/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451